



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,461	09/10/2003	Roy Lim	4002-3343/PC928.00	4931

7590 09/13/2006

Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
----------	--------------

3733

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,461

Applicant(s)

LIM, ROY

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 46-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 21-25, 32-39, 44 and 45 is/are rejected.
- 7) ☒ Claim(s) 10-20, 26-31 and 40-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/12/04, 6/27/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Election/Restrictions

Applicant's election without traverse of Group 1, claims 1-45, in the reply filed on 6/22/06, is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3,21,32,33,44 are rejected under 35 U.S.C. 102(e) as being anticipated by De La Barrera et al (6,569,169).

With respect to claims 1, 21,32,44, De La Barrera et al disclose a surgical instrument comprising a handle (31) at a proximal end of the instrument, an actuator assembly (30) extending along a longitudinal axis and operably coupled with the handle assembly; and an implant engaging portion (11) at the distal end of the instrument, the implant engaging portion including a holder (23) positionable in contact with the implant and a clamp assembly (20) coupled with the actuator assembly, the clamp assembly includes a pair of distal arm portions (21,22) adjacent the holder and movable toward one another to engage the implant between the distal arm portions, the distal arm portions further being movable proximally relative to the holder with the actuator assembly upon manipulation of the handle assembly to release the implant from

between the distal arm portions while the holder maintains contact with the implant; as set forth in column 3, lines 42-65, column 4, lines 55-67, column 5, lines 1-60, column 6, lines 1-67; and as best seen in FIGS.1-8.

With respect to claims 3, 33, De La Barrera et al disclose all the limitations, asset forth in column 3, lines 42-65, column 4, lines 55-67, column 5, lines 1-60, column 6, lines 1-67; and as best seen in FIGS.1-8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-7, 22-25,34-36,45 rejected under 35 U.S.C. 103(a) as being unpatentable over De La Barrera et al. (6,569,169) in view of Fuss et al. (6,599,294).

With respect to the above claims, it is noted that De La Barrera et al teach all the limitations, except for a cradle surface extending along and between the first and second extensions and a distal arm that is curved along the longitudinal axis to offset the distal ends to a first side of the longitudinal axis; as claimed by applicant. However, in a similar art, Fuss et al evidences the use of a surgical instrument having a cradle surface extending between the extensions and a distal arm that is curved along the longitudinal axis to offset the distal ends to facilitate the introduction of the implant even when access is difficult.

Therefore, given the teaching of Fuss et al., it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the device of De La Barrera et al, as taught by Fuss et al to facilitate the introduction of the implant even when access is difficult.

Claims 8, 9, 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Barrera et al. (6,569,169) in view of Janzen (6,126,674).

With respect to the above claims, it is noted that De La Barrera et al teach all the limitations, except for first and second handle members pivotally coupled; as claimed by applicant. However, in a similar art, Janzen evidences the use of a surgical instrument including a first handle member and second handle member pivotally coupled to the first handle member to be turned or pivoted into the path of movement of the second leg.

Therefore, give the teaching of Janzen, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of De La Barrera et al, as taught by Janzen, to be turned or pivoted into the path of movement of the second leg.

Allowable Subject Matter

Claims 10-20, 26-31, 40-43, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,951,564

9-1999


Schroder et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
September 6, 2006


PEDRO PHILOGENE
PRIMARY EXAMINER